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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,160	09/11/2003	Daniel Joseph Heithoff	ROC920030088US1	7388
30206	7590	10/03/2007	EXAMINER	
IBM CORPORATION			MYHRE, JAMES W	
ROCHESTER IP LAW DEPT. 917			ART UNIT	PAPER NUMBER
3605 HIGHWAY 52 NORTH			3622	
ROCHESTER, MN 55901-7829				

MAIL DATE	DELIVERY MODE
10/03/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/660,160	HEITHOFF ET AL.
	Examiner James W. Myhre	Art Unit 3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 11 September 2003.  
 2a) This action is FINAL.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-21 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-21 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 11 September 2003 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date 9/03.

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

1. This Office Action is in response to the initial filing on September 11, 2003.

Claims 1- 21 are currently pending and have been considered below.

### ***Specification***

2. The disclosure is objected to because of the following informalities: on page 9, line 9, there should be a space separating “1” and “are” in “Fig. 1are”.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 12-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 12-16 are directed to “A signal-bearing medium”. The Applicant has defined a variety of signal-bearing media to include “(3) information conveyed to a server by a communications medium, such as through a computer or a telephone network, e.g. the network 105, including wireless communications.” (page 8, lines 27-29). The Office considers a signal (transmitted through wired or wireless communication mediums) to be a form of electromagnetic energy per se. Energy is not

a series of steps, and thus is not a process or method. Energy also is not a machine nor a product of manufacture. Additionally, energy is not a composition of matter. Therefore, a claim directed towards a signal does not fall within any of the four recognized classes of statutory subject matter under 35 U.S.C. 101.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Fawcett (5,845,077).

Claim 1: Fawcett discloses a method for recommending an offering based on data received from a client and a threshold (column 6, lines 12-32).

Claim 2: Fawcett discloses a method as in Claim 1 above, and further discloses comparing the data to the threshold and sending the offer upon satisfaction of the threshold (column 2, lines 30-45 and column 6, lines 12-32).

Claims 3 and 4: Fawcett discloses a method as in Claim 1 above, and further discloses the data comprises a hardware and/or software inventory of the client computer (column 1, lines 25-29 and column 2, lines 30-32).

Claims 5 and 6: Fawcett discloses a method as in Claim 1 above, but does not explicitly disclose the data comprises a performance inventory or a trend of the client. However, based on the disclosure in Fawcett that the client computers periodically need updates such as new device drivers, new operating system calls, help files, etc., it would have been obvious to one having ordinary skill in the art at the time the invention was made to include updates based on the client computer's performance and/or trends. One would have been motivated to use the client's performance/trend data in order to determine when Fawcett's new device drivers and/or operating system calls were needed.

Claims 7, 12, and 17: Fawcett discloses a server, signal, and apparatus comprising:

- a. receiving an inventory from a client (column 2, lines 30-45 and column 6, lines 12-32);
- b. comparing the inventory data to a plurality of thresholds (column 2, lines 3-45 and column 6, lines 12-32); and
- c. selecting and sending one or more offers based on the comparison of the inventory and thresholds (column 6, lines 12-32).

Claim 8: Fawcett discloses an apparatus as in Claim 7 above, and further discloses saving a history of inventory changes (column 8, lines 53-55 and column 9, lines 46-52).

Claim 9: Fawcett discloses an apparatus as in Claim 8 above, and further discloses comparing a plurality of records in the history (column 6, lines 12-32 and column 7, lines 29-35).

Claim 10: Fawcett discloses an apparatus as in Claim 7 above, and further discloses the offer is for a service (e.g. help files)(column 7, lines 35-44).

Claim 11: Fawcett discloses an apparatus as in Claim 7 above, and further discloses the offer is for hardware (column 1, lines 25-29 and column 7, lines 35-44).

Claims 13 and 20: Fawcett discloses a signal and server as in Claims 12 and 17 above, and further discloses sending an identification of a marketing channel (i.e. a link) to the client in order to purchase the offer if accepted (column 10, lines 36-48).

Claims 14 and 21: Fawcett discloses a signal and server as in Claims 12 and 17 above, and further discloses periodically receiving updates of the inventory data from the client (column 9, lines 46-52 and column 10, lines 54-56).

Claims 15 and 16: Fawcett discloses a signal as in Claim 12 above, and further discloses receiving the updates of the inventory data after the occurrence of an event, such as installation of hardware, installation of software, or detection of a performance problem at the client (column 9, lines 46-52).

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Schmidt et al (4,558,413) discloses a method for managing software versions by automatically detecting and updating newer versions.
- b. Hill (5,761,649) discloses a method for updating a remote computer based on detection of installed hardware and software.
- c. Crawford (5,771,354) discloses a method for online backup of remote computers that also automatically monitors and downloads new releases to software, virus detection software, diagnostic and repair services, etc.
- d. Slivka et al (6,049,671) discloses a method for identifying and obtaining computer software updates and new software from a network computer.
- e. Saboff (6,154,878) discloses a method for on-line replacement of software with new versions of the software during runtime.
- f. Slivka et al (6,256,668) discloses a method for identifying and obtaining new or updated software or services.

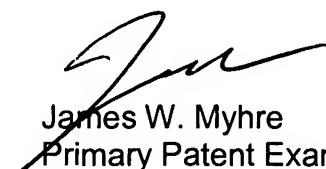
Any inquiry concerning this communication or earlier communications from the examiner should be directed to James W. Myhre whose telephone number is (571) 272-6722. The examiner can normally be reached on Monday through Thursday 6:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



JWM  
September 19, 2007



James W. Myhre  
Primary Patent Examiner